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NOV 27 1928
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No. 559

In the Supreme Court of the United States.

OCTOBER TERM—1928.

EDWARD BECHER,

Petitioner,

vs.

CONTOURE LABORATORIES, INC., and HERBERT OPPENHEIMER,

Respondents.

PETITION FOR A WRIT OF CERTIORARI.

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In the Supreme Court of the United States.

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PETITION FOR A WRIT OF CERTIORARI.

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, EDWARD BECHER, plaintiff below, prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit to review the decision of said Court rendered November 19, 1928, in the above entitled case which appears in the transcript of record filed herewith.

The Issue.

Your petitioner states that the matter involved is whether, on the facts of this case, a State Court had jurisdiction to try and determine a Patent Office interference and thereby oust the jurisdiction of the Patent

Office and also the jurisdiction of the United States Courts, when functioning to determine who is the original, first and sole inventor, under the patent laws of the United States, of the subject matter in dispute.

It is believed that this controversy will turn on the interpretation to be placed on the decision of this Court in the case of *Pratt* vs. *Paris Gas Light & Coke Co.*, 168 U. S. 255, 259, where this Court, speaking through Mr. Justice Brown, said:

> "The action under consideration is not one arising under the patent right laws of the United States in any proper sense of the term. To constitute such a cause the plaintiff must set up some right, title or interest under the patent laws, or at least make it appear that some right or privilege will be defeated by one construction, or sustained by the opposite construction of these laws * * *.
>
> "* * * There is a clear distinction between a case and a question arising under the patent laws. The former arises when the plaintiff in his opening pleading—be it bill, complaint or declaration—sets up a right under the patent laws as ground for a recovery. Of such the state courts have no jurisdiction. The latter may appear in the plea or answer or in the testimony. The determination of such question is not beyond the competency of the state tribunals."

The prevailing opinion in the case at bar, (Rec., p. 114), puts one construction on the foregoing and the dissenting opinion (Rec., p. 124), puts another. The construction of the prevailing opinion permits the State Court to try and determine the issue of priority raised affirmatively in the complaint in the State Court proceedings. The dissenting opinion denies that the State

Court had any legal right so to do. These opinions differ as to whether the Patent Office issue of priority is incidental or fundamental to the cause of action stated in the complaint in the State Court. They agree in finding this issue essential, and determined.

The Facts.

The facts on which both these opinions are based and on which this issue of law arose are as follows:

1. Edward Becher, your petitioner, is the patentee of Letters Patent in suit No. 1,634,316, granted July 5, 1927, for a **massaging heating roller** on an application filed March 27, 1926. (Rec., p. 16.) This is the patent in suit on which the cause of action at bar is based, the suit being brought for infringement and for the incidental relief of an injunction to prevent the enforcement of a judgment obtained in a State Court (Rec., p. 9), as will be explained below.

2. Late in 1925, Becher had certain negotiations with Oppenheimer, one of the respondents, and as a result of these negotiations, Becher reproduced the massaging iron of Oppenheimer and made some thirty five replicas of the same. These irons are not in any way disputed. (Rec., pp. 36 to 42.) They were failures and had to be changed. It is alleged by respondents that Oppenheimer gave confidential instructions to Becher with regard to these irons and work thereon, by virtue of which Becher was to keep secret and confidential any disclosure made to him by Oppenheimer. (Rec., pp. 36 and 37.) Becher denies this. (Rec., p. 14.) At a later date, June, 1926, Oppenheimer incorporated his business and became President of the corporation, the other respondent at bar (Rec., p. 23 and p. 52), but as the other respond-

ent stands in his shoes and as it is alleged in the bill of complaint, that these two respondents conspired and confederated together to defeat the rights of Becher (Rec., p. 4), it is not necessary to distinguish between the two, and we will proceed in this case as if Oppenheimer and his company were one and the same.

3. After the failure of Oppenheimer as to the massaging machines, above mentioned, each of which had three rollers, Becher made for Oppenheimer, showed to Oppenheimer, and disclosed to Oppenheimer, a single roller machine. Becher claims that this was his own invention and for this, he took out the patent in suit. (Rec., p. 4.) Oppenheimer claims that he confidentially disclosed this to Becher and Becher fraudulently took out the patent in suit. (Rec., pp. 36, 37, 18, 19 and 20.)

4. On June 26, 1926, Oppenheimer filed his application in the Patent Office of the United States. (Rec., p. 54.) Whether or not he knew at this time that Becher had already applied for a patent is disputed and need not be commented on as we believe it makes no difference as to the decision which this Court will reach. As filed, the Oppenheimer application in no way related to the invention of the Becher patent. (Rec., p. 67.)

5. After the disclosure by Becher of the single roller machine, Oppenheimer gave substantial orders for such single roller machines to Becher which orders were filled and paid for in due course and this continued until August, 1927. (Rec., p. 4.)

6. In August, 1927, Becher disclosed his patent to Oppenheimer, which he had obtained the preceding July 5th, and thereupon there was a quarrel between the parties and no new orders have been given by Oppen-

heimer to Becher. Thereafter, orders have been placed elsewhere for these machines and this gave occasion for the infringement suit at bar. (Rec., p. 4.)

7. When Oppenheimer discovered that Becher had a patent, he took a copy to his attorney and amended his application so as to incorporate the claims of Becher and did this on the usual oath, and thereby instituted the interference proceedings which caused the interference to be declared between the two parties under date of October 19, 1927, which interference is now pending, between the parties, and is undetermined. (Rec., p. 8.) The declaration of interference is found in the record at page 28.

8. Oppenheimer, having initiated the interference proceedings, as above stated, did not wait for the interference to be declared, but went to the equity side of the Supreme Court of the State of New York for Kings County and asked for injunctive relief against Becher on the ground that Oppenheimer was the original, first and sole inventor of the Becher patent and that Becher fraudulently appropriated to his own use and behoof the ideas of Oppenheimer and fraudulently obtained the patent here in suit and above mentioned. Becher objected to the jurisdiction of the State Court in this matter and was overruled and he was forced to answer and the case went to trial and was decided adversely to Becher, it being affirmatively found, pursuant to the complaint, that Oppenheimer, and not Becher, was the original, first and sole inventor of the subject matter of Becher's patent and an injunction was granted, also pursuant to the complaint, directing that Becher forthwith assign his patent to Oppenheimer, the other respondent, the Contoure Laboratories, Inc., having consented to this. (Rec., pp. 6 to 9.) (An appeal has been

taken from this judgment, to the Supreme Court, Appellate Division, Second Judicial Department of the State of New York, and the appeal is pending undetermined.)

9. Before the decision, in the State Court, could become effective, the respondent Becher had learned of the infringements above stated, and thereupon brought the bill of complaint in the suit at bar and asked for a preliminary injunction, restraining the infringement of his patent and restraining enforcement of the judgment in the State Court, above referred to. (Rec., p. 9.) The matter came on for hearing on this motion for preliminary injunction, and was denied by the trial Court without an opinion. (Rec., p. 34.) The matter was then appealed by Becher, the petitioner here, to the Circuit Court of Appeals for the Second Circuit and the decision of the lower Court was affirmed in the prevailing opinion with the dissenting opinion, above noted. The prevailing opinion also directs, pursuant to the *Mast Foos* case, 177 U. S. 485, that the bill of complaint be dismissed because the plaintiff in the suit at bar cannot ultimately prevail, so that the decision of the Circuit Court of Appeals is, in substance, a final one in this case. (Rec., p. 123.)

Conclusion.

The petitioner now comes and asks this Court to intervene by granting this petition for a writ of certiorari and directing that the entire matter may be brought here for the consideration and determination of this Court. The position of the petitioner is ably set forth in the dissenting opinion of the Circuit Court of Appeals and it is believed that this petition should be granted in view of the public importance of this case as

to deciding the jurisdictional question between State Courts and Federal Courts in the matter at issue. This dissenting opinion of Judge Manton makes a brief unnecessary for petitioner. The petitioner prays for the relief which Judge Manton says should be granted, (Rec., p. 130) and asks that the case be reversed and remanded accordingly.

Wherefore, your petitioner prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit, requiring it to send to this Court a proper transcript of the record in that Court and that this Honorable Court may review the decision of said Circuit Court of Appeals and for such other and further relief as may be appropriate.

Edward Becher,
By O. Ellery Edwards,
Counsel for Petitioner.

Certificate of Counsel.

As a member of the bar of this Court, I hereby certify that I have examined the foregoing petition and in my judgment it is well founded and the cause is one in which the prayer of the petition may properly be granted by this Court.

O. Ellery Edwards.

Dated New York, November 20th, 1928.